

REMARKS

At the time of the Office Action, claims 1, 3, 4, 6, and 16–25 were pending. Claim 19 is withdrawn as being directed to a non-elected species. Claims 1, 3, 4, 6, 16–18 and 20–25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0167706 (Pazar) in view of U.S. Patent No. 4,219,596 (Takemoto, et al.).

Applicants respond as follows.

35 U.S.C. §103(a) Obviousness of Claims 1, 3, 4, 6, 16-18 and 20-25 over Pazar in View of Takemoto

1. One of ordinary skill in the art would not seek to combine Pazar, teaching a durable identification nameplate, with Takemoto, teaching a transparent film decorative label to arrive at the invention claimed by independent claims 1, 16, and 17. The unpredictable results are not results, as asserted by the Examiner, of the appearance improvement of the carapace, but rather the enhancement of commercial viability of a carapace that has a very limited viewability by the purchasers.

In the Office Action, on pp.2–3, the Examiner rejected independent claim 1 as being obvious over Pazar in view of Takemoto.

In the Office Action, the Examiner indicated that Pazar discloses a metal substrate having a decorative graphic attached/adhered to a top surface. The Office Action further notes that while Pazar discloses a metal substrate having a decorative graphic it “fails to disclose the substrate as being a transparent substrate having a decorative graphic printed thereon wherein the substrate is attached to the carapace via a transparent adhesive.”

To cure this deficiency, the Examiner provided the Takemoto reference as disclosing, “a transparent substrate 16 having a decorative graphic 18 printed thereon wherein the substrate is attached to a structure via a transparent adhesive...such that the graphic appears to be part of the structure as opposed to appearing ‘stuck on’....”

The Examiner stated, as a motivation to combine these references:

...it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pazar by replacing the metal substrate with a transparent substrate having a decorative graphic printed thereon wherein the

substrate was attached to the carapace via a transparent adhesive to enhance the appearance of the vault.

This rejection was essentially repeated from the previous office action, although the Examiner did add a rationale supporting the conclusion of obviousness from MPEP 2143 and the *KSR International Co. v. Teleflex* decision (as noted in the argument bodies and in the Response to Arguments section) (Applicants thank the Examiner for the non-finality of this office action and providing them with an opportunity to address these *KSR* factors grounds of rejection). The Examiner indicated that the conclusion of obviousness is:

[T]he proposed combination is based upon a simple substitution of one known element for another to obtain predictable results [citation omitted]. The substitution of the metal substrate with a transparent substrate having a decorative graphic printed thereon wherein the substrate was attached to the carapace via a transparent adhesive would improve the appearance of the vault as the graphic would appear to be part of the structure.

The problem addressed by the invention is how to increase the commercial desirability of burial vaults, particularly given the fact that the burial vault is not typically used in a funeral service or public viewing other than the brief services that typically accompany the burial graveside.

The Examiner indicated that the substitution of the decorative graphic for the metal plate of Pazar would obtain predictable results... namely, improving the appearance of the carapace. However, the Examiner misstates and oversimplifies the nature of the predictable results—it is not the mere improvement of the appearance of the carapace, it is that a particular type of improvement of the appearance of the carapace (out of many different possible types of appearance improvement) would result in an overall commercial desirability of burial vaults. This is contrary to what one of ordinary skill in the art would conclude given, as mentioned above, that the burial vault is not typically used in a funeral service or public viewing other than the brief services that typically accompany the burial graveside. Applicants' affidavit, which is discussed in more detail below, clearly indicates a commercial success and copying by others that would make this realization non-obvious.

In addition to what was discussed in the prior response, Applicants respectfully assert that the Examiner has not considered “the invention as a whole”, as required under MPEP §2141.02(I) (and supporting case law)—it is not a question of whether the differences

themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Furthermore, as provided under MPEP §2141.02(III) (and supporting case law), discovering the source/cause of a problem is part of the “as a whole” inquiry. The Applicants have recognized, out of various potential ways to improve the commercial desirability of a burial vault, that an applied graphic image, as claimed, would improve the commercial desirability of a burial vault, even when the burial vault is not typically used in a funeral service or public viewing other than the brief services that typically accompany the burial graveside. It is this aspect that has been ignored by the Examiner. The inclusion of a decorative graphic on a cinder block intended for an unviewable internal wall of a building would very likely not increase its commercial desirability, although, based on the Examiner’s argument, would improve the appearance of the cinder block—clearly, this is not the issue.

The remaining portion of the response under this heading is essentially repeated from the previous response.

Pazar recognized that providing durable identification and data about the deceased in connection with the burial vault would improve its desirability (see paragraph [0008]). Pazar achieves this by two mechanisms—as to the data about the deceased, a durable and sealed record receptacle 140 is provided that can contain a written record provided by friends and family of the deceased. This small record receptacle is designed to be placed in a receiving hole of the burial vault and sealed, where its contents are relatively immune from the elements. As to durable identification, Pazar achieves this by a name plate 2310 made of metal [0084] adhered to the lid.

Therefore, Pazar recognized one of many ways for improving the desirability of a burial vault, namely by enhancing a preservation of the identity and information associated with the deceased. In the event that, e.g., a flood carries away the burial vault, the problems associated with identifying its contents can be avoided [0002]. However, this solution is not an appearance-related solution.

There are numerous other potential mechanisms that could be used to enhance the desirability of a burial vault. A brief and informal survey of the industry indicates that other non-appearance-related solutions have been implemented, such as strength, integrity, protection from the environment, materials, etc. And for those few mechanisms that could

conceivably be appearance-related, these seem to revolve around cross-sectional shapes, molding, and characteristics of the materials used.

In the present application, the Applicants recognized a solution to improving the desirability of a burial vault that had not been recognized before—the addition of a graphic label to enhance the overall desirability of the burial vault by visual means that does not involve cross-sectional shapes, moldings, etc. This solution had not been recognized in the industry previously.

In Pazar, the issue being addressed is the durability of identifying indicia. Therefore, it would make sense in Pazar to construct the identifying indicia name plate of a very durable material—namely metal. The attributes of the substrate in claim 1 are not those that one of ordinary skill in the art would turn to if the issue of durability was of primary concern, as the metal nameplate of Pazar would much better serve as a durable identifying indicia. Therefore, one of ordinary skill in the art would not consider the teaching of Pazar in improving the desirability of a burial vault as is achieved in present claim 1 by providing durable identifying and describing indicia in the form of a metal nameplate and environmentally sealed data capsule, and would not have a motivation to consider the use of the labels disclosed by Takemoto if such durability were a concern.

The attributes of the substrate of previously amended claim 16 are not those that one of ordinary skill in the art would turn to if the issue of durability was of primary concern, as the metal nameplate of Pazar would much better serve as a durable identifying indicia. Therefore, one of ordinary skill in the art would not consider the teaching of Pazar in improving the desirability of a burial vault by providing durable identifying and describing indicia particularly illuminating with regard to the present invention, as discussed above.

Similarly, with regard to claim 17, the substrate covers substantially the first surface of the container. One concerned with providing a desirable burial vault as presently claimed by claim 17 would not turn to the durable identifying indicia disclosed by Pazar since it would make no sense to provide a nameplate that covers substantially the first surface of the container. Secondly, even if such a large nameplate were desirable, then its construction out of a durable metal would make it cost prohibitive, at least in a commercially viable marketplace.

In the present Office Action, the Examiner has engaged in impermissible hindsight in combining the references of Pazar and Takemoto. The Examiner has used the Applicants own disclosure as providing the motivation and desirability for providing combining the references to arrive at the presently claimed solution. Out of the myriad of possible ways of improving the desirability of a burial vault, numerous other mechanisms have been employed (durability of identifying indicia, structural aspects, moldings, etc.), but no one recognized that providing a graphical label, as presently claimed, would achieve the improvement of desirability presently achieved.

As prohibited by MPEP §2145(X)(A), the Examiner, having taken the cue from the Applicant's disclosure that the addition of a graphic label having the claimed attributes is a solution for making a burial vault more desirable, then, simply in hindsight, located the Takemoto reference showing such a label, and concluded that this would have been an obvious combination. It was unknown, at the time the invention was made, that the addition of a graphic image having the claimed features would result in a more commercially desirable burial vault, and one at the time of the invention could have determined that such a feature was actually undesirable or, at the very least, unnecessary, and therefore, cost prohibitive or lacking in commercial common sense.

As noted by MPEP §2143.01(III), the mere fact that the references can be combined or modified may not be sufficient to establish *prima facie* obviousness. Here, the Examiner has simply pointed to two references that teach differing aspects, differing applications, and different motivations for use and concluded that one of ordinary skill in the art would be motivated to combine them. Again, however, this is only after the solution of applying a graphic in accordance with the disclosure of the invention was taught by the applicants. The motivation cited by the Examiner "to enhance the appearance of the vault" (p. 4) and "the transparent substrate of Takemoto is a more visual[ly] appealing arrangement than that of the metal substrate of Pazar" fails to take into account the many possible ways for enhancing the commercial desirability of the vault, the other ways historically used to enhance the desirability and appearance of the burial vault, and the fact that Pazar's motivation includes durability for identification purposes.

Thus, for these reasons alone, Applicants respectfully assert that the independent claims of the present invention, with claims as amended, is not obvious over the combination of Pazar and Takemoto.

2. The revised declaration of Marty Jay Cox demonstrates the non-obviousness of the present invention by demonstrating commercial success of the invention. The evidence of actual market sales figures demonstrating increased market share negates the need to separately provide evidence as to expected market sales figures over a time period.

In addition to the above arguments, however, the Applicants previously submitted a revised declaration of Marty Jay Cox with demonstrates the non-obviousness of the present invention by its commercial success.

Prior Response

In a previous response to an earlier office action, Applicants submitted an Affidavit / Declaration pursuant to 37 C.F.R. §1.132, which argued that the commercial success of the product being sold further supported its non-obvious nature.

In the prior Office Action, on pp. 7–8, the Examiner concluded that this declaration was insufficient to overcome the rejection under 35 U.S.C. §103 based on a number of deficiencies.

As the Examiner noted, the previously submitted declaration did not make reference to individual claims of the application, and only relied upon gross sales figures to demonstrate commercial success, absent evidence as to market share.

Applicants then submitted a revised declaration of Marty Jay Cox that addressed these deficiencies. With respect to paragraph no. 7 of the declaration, the Examiner's attention was directed to a revision from the previously submitted declaration that included a recitation of the features of at least claim 1 in the application, thereby addressing the Examiner's first cited basis of insufficiency.

Paragraph nos. 8–15 were asserted to provide the best evidence available to the Applicants as to the gross market sales figures. Although some of the values used were based on market projections (projections vs. actuals are clearly identified in the declaration), these projections were provided by a well-respected, unbiased, and well-established industry

organization. Applicants asserted that this evidence shows that despite an overall trend resulting in more cremations and a decreasing demand for burial vaults, the Applicants percent of market share has steadily increased over the years.

Furthermore, as indicated in the declaration, no solution to increasing the desirability of burial vaults to consumers according to the presently claimed invention existed in the marketplace prior to the Applicants showing at a trade show—however, in the immediate year following this showing, there was an explosion among competitors in the marketplace for products precisely in line with what was shown at the trade show and what was claimed in the present patent application.

Response to Current Rejection

In the present Office Action, the Examiner, on p. 5, indicated:

The affidavit of Marty Cox filed under 37 CFR 1.132 on 07-08-2008 is insufficient to overcome the rejection of claims 1, 3, 4, 6, 16–18, and 20–25 based upon the 35 U.S.C. 103 rejection of Pazar in view of Takemoto as set forth in the current Office [A]ction because:

1) The provided sales figures are not adequately defined as no data was presented as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988).

The Examiner appears to be citing this basis of rejection from MPEP §716.03(b)(IV). However, the Examiner misstates the requirement, as this MPEP section actually states:

IV. < SALES FIGURES MUST BE ADEQUATELY DEFINED

Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988).

Thus, although this section clearly indicates that mere gross sales figures are inadequate to show commercial success, there are two evidentiary *alternative* mechanisms for remedying this: a) providing evidence of market share; *or* b) providing evidence as to what sales would normally be expected in the market.

In fact, *Ex parte Standish* actually contains a more accurate statement of the requirement than the MPEP, stating, at 1458:

However, the only evidence of record concerning commercial success comprises a statement by the inventor in the § 1.131 affidavit that more than 5,000 lures “constructed according to the disclosure and claims of my patent application” have been sold. The affidavit statement does not reflect the time period during which the lures were sold or the **average number of product sales per unit of time** which would normally be **expected in the market place** under consideration. Accordingly, we cannot determine whether appellant's lure, in fact, has been commercially successful. [emphasis added]

Thus, alternative (b) would be an option for one to provide commercial success evidence beyond mere gross sales figures if he did not have available the overall industry-wide sales from which market share information would necessarily be derived. However, if he had available (as we have here) reasonably accurate estimates of actual sales in the marketplace, then the expected sales in the marketplace is rendered moot.

In the present case, Applicants do have a good indication of overall actual market sales, and are thus able to sufficiently demonstrate an increasing market share based thereon, as provided under alternative (a)—this demonstration under alternative (a) is sufficient to adequately define the sales figures that demonstrate commercial success.

In the alternative, Applicants argue that the evidence of actual sales in the marketplace serve as an adequate proxy as to what expected sales in the marketplace would be (in proportion to Applicants’ previous market share) and therefore do constitute the type of evidence the Examiner indicates is lacking in the affidavit.

Having addressed the Examiner’s indication of shortcomings in the previously submitted revised declaration, Applicants respectfully assert that the previously submitted declaration and its supporting exhibits provide compelling evidence of non-obviousness in accordance with the criterion established in *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

In re Appln. of Cox et al.
Application No. 10/775,746
Response to Office Action of September 30, 2008

CONCLUSION

Based on the discussion presented above, the application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

/mark bergner/

Brian C. Rupp, Reg. No. 35,665
Mark Bergner, Reg. No. 45,877
DRINKER BIDDLE & REATH LLP
191 N. Wacker Drive, Suite 3700
Chicago, Illinois 60606-1698
(312) 569-1000 (telephone)
(312) 569-3000 (facsimile)
Customer No.: 08968

Date: December 30, 2008